

**REMARKS**

Claims 1-5, 7-12, 14-19, 21-28 and 30-31 are pending in the application.

Claims 1-5, 7-12, 14-19, 21-28 and 30-31 are rejected.

Claims 1, 8, 15, 21-23 and 30-31 are amended.

Reconsideration and allowance of all pending claims is respectfully requested in view of the following:

***Responses to Rejections to Claims – 35 U.S.C. §103***

Claims 1-5, 8-12, 15-19, 21-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al (U.S. Patent No. 5,027,343) (Chan hereinafter) in view of Raj et al (U.S. Patent No. 6,373,822) (Raj hereinafter). Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Raj in view of the Applicant's Admitted Prior Art (AAPA hereinafter). These rejections are not applicable to the amended claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach all of the elements of the pending claims.

For example, the pending claims substantially recite, in part, a local burn rack located at the local site for receiving the first SUT and a remote burn rack located at the remote site for receiving the second SUT such that the first and second SUTs are tested and software is configured while operating together on the VLAN. As conceded by the Examiner on pages 2 and 3 of the Final rejection, "Chan does not specifically disclose a local burn rack located at the

local site for receiving the first SUT and a remote burn rack located at the remote site for receiving the second SUT such that the first and second SUT's are configured and tested while operating together on the VLAN." It is submitted that this deficiency is not remedied by RAJ.

The Final Office Action states on pages 5-6 that

a local burn rack is broadly interpreted as a rack or enclosure for a switch or device. The examiner notes that the specification is not read into claims, and without specifying the term local burn rack, the examiner is open to broad interpretation. Furthermore, Raj discloses in fig 10 switching routers 200A and 200B used for testing, located locally and remotely respectively. The rejection of claim 1 explains that these switching routers are not merely sitting on the floor or being held by a human being. The switching routers are known within the art to be held by a rack or unit of some sort, where this rack or unit is equivalent to a burn rack.

This statement is traversed. A "burn rack" as used in the Application does not refer simply to a rack or enclosure for a switch or device. Instead, a "burn rack" is a rack where assembled computer systems are placed for testing and software configuration. According to the Application "In a computer manufacturing environment, once a computer system is physically assembled, it is placed in a bay, or "cell," in a burn rack for testing and software configuration." p.3, lines 6-7. As such, Raj does not teach a local burn rack located at the local site for receiving the first SUT and a remote burn rack located at the remote site for receiving the second SUT such that the first and second SUTs are tested and software is configured while operating together on the VLAN.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In combining multiple references for a 103 rejection, the Supreme Court has ruled that the "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739. The Court stated that "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741, emphasis added.

In the present case, the Examiner has not expressed any reason why a person of ordinary skill in art would combine the references in the way the claimed new invention does.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 8, 15, 21-23 and 30-31 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of all pending claims is respectfully requested.

The amended claims are supported by the original application. The Office Action contains characterizations of the claims and the related art to which the Applicant does not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Claims 1, 8, 15, 21-23 and 30-31 are amended herein in order to expeditiously advance prosecution of this application. The amendments do not necessarily provide an indication that Applicants agree with any conclusions set forth in the Office Action regarding patentability of the claims including that a prima facie rejection is established by the references.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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